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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/480,850	06/07/95	PELLETT	P 1414.657

HM12/0927

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EXAMINER	
LEARY, L	

ART UNIT	PAPER NUMBER
1623	28

DATE MAILED: 09/27/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.	Applicant(s)
08/480,850	Pellet et al
Examiner	**Group Art Unit**
Louise Leary	1623

☒ Responsive to communication(s) filed on *Aug 10, 1999* .

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *three* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *7, 8, 16, and 18-21* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *7, 8, 16, and 18-21* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1623.

The Group and/or Art Unit FAX NUMBER has changed to (703) 308-3592 or (703) 305-4556.

2. Finality of the Office Action mailed June 9, 1998 is withdrawn. An office action on the merits is given below.

3. Claims 7-8, 16 and 18-21 are pending in this application. Claims 1-6, 9-15 and 17 have been canceled per applicants request.

4. Applicant's arguments filed August 10, 1999 have been fully considered found persuasive.

The 35 USC 103 rejection of claims 7-8, and 16-21 as unpatentable over Lee et al (AA1) or Lee et al (AW) in view of Luckow et al (AO), Matsuura et al (AP) and further in view of Krishna et al (J. Gen. Virology, 1989) is withdrawn.

5. *OBJECTION TO CLAIMS:*

Claims 7-8, 16 and 18-21 are objected to for omitting the Amino Acid Sequence ID Number. Correction is required to comply with 37 CFR 1.821 to 1.825.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

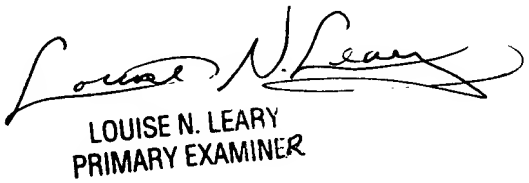
made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7-8, 16 and 18-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sanchez-Martinez, D. et al ("Amer. Soc. for Vir", Annual Meeting, London, Ontario (1989).

Sanchez-Martinez, D. et al show recombinant herpes simplex virus gG-1 (HSV-1) and herpes simplex virus gG-2 (HSV-2) glycoproteins produced using a bacovirus transfer vector. Also, Sanchez-Martinez, D. et al describe a method for expression of HSV-1 and HSV-2 glycoprotein G in insect cells by using a bacovirus transfer vector. Hence, Sanchez-Martinez, D. recombinant herpes simplex virus gG-1 (HSV-1) and herpes simplex virus gG-2 (HSV-2) glycoproteins as claimed except for describing the property of the HSV 1 and HSV 2 glycoproteins by specifically stating "a nontranslated polyhedrin gene leader sequence CTATAAAT joined to the 5' end of a polyhedrin gene translation initiation codon ATG, and having the polyhedrin gene translation initiation codon ATG joined to the 5' end of the coding region of a foreign gene, without any extraneous nucleotide between the 5' end of the nontranslated polyhedrin gene leader sequence CTATAAAT, the polyhedrin gene translation initiation codon ATG and the 5' end of the coding region of a foreign gene, wherein said foreign gene is herpes simplex virus type 1 glycoprotein gene."; and showing HSV-1 and HSV-2 in a pharmaceutically acceptable carrier." However, Sanchez-Martinez, D. et al show all the claim

limitations except for using the claim language set forth above to describe the property of the recombinant HSV-1 and HSV-2 glycoproteins produced. The examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention. In regards to a composition comprising recombinant HSV-1 and HSV-2 glycoproteins in a pharmaceutically acceptable carrier, the examiner takes the position that making the instant composition at the time this invention was made was well within the purview of one having ordinary skill in this art at the time this invention was made because HSV-1 and HSV-2 recombinant glycoproteins were previously known in this art. Thus, applicants have the burden of proof to show patentably distinct differences between the recombinant HSV-1 and HSV-2 glycoproteins of the invention claimed and the recombinant HSV-1 and HSV-2 glycoproteins of the Sanchez-Martinez, D. et al reference. See In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980).

7. Any inquiry concerning this communication should be directed to Louise Leary at telephone number (703) 308-3533.



LOUISE N. LEARY
PRIMARY EXAMINER

September 24, 1999